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PATENT APPLICATION

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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Daryl E. Anderson et al.

Confirmation No.: 6766

Application No.: 10/613,842

Examiner: M. Bogart

Filing Date: July 3, 2003

Group Art Unit: 3761

Title: OPHTHALMIC APPARATUS AND METHOD FOR ADMINISTERING AGENTS TO THE EYE

Mail Stop Appeal Brief - Patents
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TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on December 14, 2007 .

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of | Dated: February 13, 2008

DARYL E. ANDERSON
and JOHN STEPHEN DUNFIELD | HP Docket No. 200208831-1

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S i r :

REPLY BRIEF OF APPELLANTS

This Reply Brief of Appellants is presented in reply to the Examiner's Answer dated December 14, 2007.

I. Status of Claims

At the time of appeal to the Board, claims 1-20 and 22-32 stood rejected variously under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a).

Claims 1-6, 8-10, 14-16, 18, 19 and 28-31 stood rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,270,467 to Yee ("Yee"). Claims 7, 11-13, 17, 20, 22-27 and 32 stood rejected under 35 U.S.C. § 103(a) based on Yee, variously in view of U.S. Patent No. 5,368,582 to Bertera ("Bertera"), U.S. Patent No. 6,299,305 to Miwa ("Miwa"), U.S. Patent No. 5,171,306 to Vo ("Vo") and/or U.S. Patent No. 6,159,186 to Wickham et al. ("Wickham").

Claims 1-4, 6, 9-18, 20, 22, 28 and 30-32 were provisionally rejected under the non-statutory, obviousness-type double patenting doctrine based on co-pending U.S. Patent Application Serial No. 10/412,057 to Anderson et al. ("the '057 application"). In the Examiner's Answer, the Examiner notes that the '057 application has issued as U.S. Patent No. 7,201,732, and thus indicates that the provisional obviousness-type double patenting rejections are no longer provisional.

II. Status of Amendments

The Examiner correctly notes that there was no Office action dated December 15, 2006. Appellants did, however, file an Amendment on December 15, 2006. No amendments have been made subsequent to the Amendment dated December 15, 2006.

III. Grounds of Rejections to be Reviewed on Appeal

Appellants have requested review of the following grounds of rejection on appeal:

1. The rejection of claims 1-6, 8-10, 14-16, 18, 19 and 28-31 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,270,467 to Yee ("Yee").

2. The rejection of claims 11-13, 17 and 32 under 35 U.S.C. § 103(a) as being obvious over Yee in view of U.S. Patent No. 5,368,582 to Bertera ("Bertera").

3. The rejection of claim 7 under 35 U.S.C. § 103(a) as obvious over Yee in view of U.S. Patent No. 6,299,305 to Miwa ("Miwa").

4. The rejection of claims 20, 22, and 23 under 35 U.S.C. § 103(a) as being obvious over Yee in view of U.S. Patent No. 5,171,306 to Vo ("Vo").

5. The rejection of claims 24-27 under 35 U.S.C. § 103(a) as obvious over Yee and Vo in view of U.S. Patent No. 6,159,186 to Wickham et al. ("Wickham").

6. The rejection of claims 1-4, 6, 17, 18, 28 and 30-32 over claims 1-49 of U.S. Patent No. 7,201,732 to Anderson et al. ("Anderson") under the non-statutory, obviousness-type double patenting doctrine (which rejection is no longer provisional).

7. The rejection of claims 9-16 over claims 1-49 of Anderson in view of Bertera under the non-statutory, obviousness-type double patenting doctrine (which rejection is no longer provisional).

8. The rejection of claims 20 and 22 over claims 1-49 of Anderson in view of Vo under the non-statutory, obviousness-type double patenting doctrine (which rejection is no longer provisional).

III. Argument

Rejections under 35 U.S.C. § 102(b)

In their Brief of Appellants, Appellants argued, among other things, that Yee does not teach each and every element as set for in the claims rejected under 35 U.S.C. § 102(b). Appellants continue to assert that Yee fails to disclose each feature of the rejected claims.

As noted in Appellants' initial brief, Yee does not disclose "an eye-positioning device for assisting a subject in positioning an eye in a desired position", as recited in Appellants' claim 1. Correspondingly, Yee fails to disclose that the eye-positioning device includes "an eye-position detector for detecting position of the eye", as recited in claim 2, and fails to disclose "detecting means for detecting the position of the eye", as recited in claim 28.

The Examiner continues to mischaracterize blinking of an eyelid as positioning of an eye. Correspondingly, the Examiner mischaracterizes detecting blinking of an eyelid as detecting position of an eye.

According to the Examiner, blinking (i.e., opening and closing of an eyelid) constitutes positioning of the eye. The Examiner thus appears to equate "eye" with "eyelid". This characterization is inconsistent with Appellants' distinct usage of the terms "eye" and "eyelid" in Appellants' specification. Accordingly, detecting position of an "eyelid" cannot properly be construed as detecting position of an "eye".

The Examiner also incorrectly asserts that Appellants have attempted to read limitations from the specification into the claims. To the contrary, Appellants refer to the

specification only in an attempt to make the distinction between "eye" and "eyelid" more clear. Rather than interpreting the claims in view of the specification, the Examiner has attempted to construe "eye" based on a proposed interpretation of Yee. Use of such extrinsic information is not appropriate when the term may be construed based on the application as originally filed.

Furthermore, even if the Examiner were permitted to construe "eye" in view of Yee, the proposed construction of "eye" would fail. As Appellants have noted, Yee also defines "eyes" as distinct and different from "eyelids". For example, Yee distinguishes eyes from eyelids, such as when it orients an enclosed area "proximal the eyes 2, eye lids, and eye sockets of the computer user 1..." (Col. 9, In. 66 – Col. 10, In. 1). Accordingly, even as used by Yee, detecting position of an "eyelid" cannot properly be construed as detecting position of an "eye". At best, Yee discloses a blink detector 16 that detects movement of the eyelid covering the eye. Yee does not even consider position of the eye as such position is not relevant to the expressed objectives of Yee.

In response to Appellants further arguments regarding claims 5 and 6, the Examiner indicates only that Yee includes a component "capable of" performing in accordance with the features set forth in the claims. The Examiner provides no support for these assertions, and does not even assert that the reference discloses the particular features as set forth in the claims.

For at least the foregoing reasons, as well as those set forth in the previously-filed Brief of Appellants, it is submitted that Appellants' invention as defined in claims 1-

6, 8-10, 14-16, 18, 19 and 28-31 is not anticipated, taught or rendered obvious by Yee, either alone or in combination, and patentably defines over the art of record.

Rejections under 35 U.S.C. § 103(a)

Claims 7, 11-13, 17, 20, 22-27 and 32 stood rejected under 35 U.S.C. § 103(a) based on Yee, variously in view of Bertera, Miwa, Vo and/or Wickham. Appellants continue to assert that the Examiner has not shown that each element of the rejected claims is disclosed by combining the cited references for at least the reasons set forth in their previously filed Brief of Appellants.

The Non-statutory Obviousness-type Double Patenting Rejections

Claims 1-4, 6, 9-18, 20, 22, 28 and 30-32 are rejected under the non-statutory, obviousness-type double patenting doctrine based on Anderson, either alone, or in view of Bertera or Vo. As noted in the Brief of Appellants, a terminal disclaimer was not filed to overcome the non-statutory double patenting rejections because Appellants believe the rejections to be improper. In particular, Appellants submit that the claims of a commonly owned or invented patent do not disclose each element of the claim at issue. M.P.E.P. § 2143. Appellants further submit that the Examiner has improperly cited the disclosure of Anderson as prior art. *See General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1279, 23 USPQ2d 1839, 1846 (Fed. Cir. 1992). However, as noted in the previously-filed Brief of Appellants, Appellants would be willing to file a terminal disclaimer to further prosecution of the application to allowance if the Board concludes that the non-statutory double patenting rejections are proper and there are no other remaining issues.

IV. Conclusion

The rejection of claims 1-20 and 22-32 under 35 U.S.C. § 102 (b), 35 U.S.C. § 103(a), and/or the non-statutory doctrine of obviousness-type double patenting is improper for at least the reasons set forth above, and in Appellants' earlier-filed Brief of Appellant. Accordingly, the rejections of all pending claims should be reversed.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on February 13, 2008.

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